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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,773	12/13/2006	Christian Merkle	016906-0484	2525
22428 7590 04/13/2010 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
ENGLE, PATRICIA LYNN				
ART UNIT		PAPER NUMBER		
3612				
MAIL DATE		DELIVERY MODE		
04/13/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/574,773

**Applicant(s)**

MERKLE ET AL.

**Examiner**

PATRICIA L. ENGLE

**Art Unit**

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/22)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: O. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plastic structure being attached to the metal base body by a separate connecting element (claims 13 and 25) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it contains legal phraseology ("comprises"). Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities: The claim numbers in the specification should be removed since the claims could change during prosecution.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Regarding claims 1, 5, 8-11, 13, 16-20, 24, 25 and 27, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
9. Regarding claims 13 and 18, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
10. Regarding claims 5, 11, 12, 14, 16, 19, 24, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
11. Regarding claims 5, 9, 11, 12, 16, 17, 19-21, 24, 25 and 27, it appears that these claims are in improper Markush group format.
12. Claim 2 and 3 recites the limitation "the longitudinal axis" in the last line. There is insufficient antecedent basis for this limitation in the claim.
13. The term "comb" in claim 3, 5 and 8 is a relative term which renders the claim indefinite. The term "comb" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

apprised of the scope of the invention. What is a comb structure? How would one of ordinary skill in the art know what a "comb" structure is?

14. The term "hat profile" in claim 18 is a relative term which renders the claim indefinite. The term "comb" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There are many types of hats, the term "hat profile" does not enable one of ordinary skill in the art to know the metes and bounds of the claim.

15. Claims 19-21 provide for the use of the component, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 19-21 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

16. Regarding claims 9, 14 and 19, the claims appear to be in dependent form, but they do not actually depend from an independent claim. For the purposes of examination, the claims will be interpreted as being dependent from claim 1.

17. Regarding claims 10, 11 and 13, the claim limitation "fixed by means" uses the phrase "means for" or "step for", but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing

the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because it is not clear whether the applicant intends other elements to be the "means" to fix or if the only structure the applicant intends is the integrally fixing element.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase "means for" or "step for" is clearly not modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does not wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for" or "step for").

18. Regarding claim 13, the phrase "can additionally" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1, 2, 6, 7, 10-12, 14, 15, 18-20, 22-24, 26 and 27 are rejected under 35 U.S.C. 102(c) as being anticipated by Roberts et al. (US Patent No. 6,942,910).

Regarding claim 1, Roberts et al. disclose a component (12), in particular a hybrid component for a crossrail of a vehicle, comprising a metal base body (22) that is at least partially provided with a plastic structure (24), the metal base body (12) having on its edge region (B) an integrally formed fixing element (44) with the aid of which the plastic structure (24) can be at least mechanically joined to the base body (22).

Regarding claims 2 and 22, Roberts et al. disclose the component as claimed in claim 1, in which, given a metal base body (22) designed as a hollow profile, the integrally formed fixing element (44) is itself formed by an edge (Fig. 3) running along the longitudinal axis.

Regarding claim 6, Roberts et al. disclose the component as claimed in claim 1, in which the integrally formed fixing element (44) at least partially surrounds the plastic structure (24) in the edge region thereof.

Regarding claims 7 and 23, Roberts et al. disclose the component as claimed in claim 1, in which the integrally formed fixing element (44) surrounds the plastic structure (24) at least in a U-shape fashion (Fig. 3).

Regarding claim 9, Roberts et al. disclose the component as claimed in claim 1, in which the integrally formed fixing element (44) is provided with at least one structural element, in particular with a rib, a web (Fig. 3), a knob, an aperture.

Regarding claim 10, Roberts et al. disclose the component as claimed in claim 1, in which the plastic structure (24) can be inserted, in particular fitted, into a cavity (Fig. 3) in the



metal base body (22), and can be positioned and fixed by means of the integrally formed fixing element (44).

Regarding claims 11 and 24, Roberts et al. disclose the component as claimed in claim 1, in which the plastic structure (24) can be fitted, in particular clipped, pinched (by 44), hooked and/or inserted with the aid of a flange connection (44), plug connection, snap connection, clip connection, caulked connection and/or hook connection in its edge region (Fig. 3) into the metal base body (22) by means of the integrally formed fixing element (44) in a self-closed and/or force-closed fashion.

Regarding claim 12, Roberts et al. disclose the component as claimed in claim 1, in which the plastic structure (24) is additionally connected in its edge region (42) to the metal base body (22) in a bonded fashion with the aid of an adhesive-bonded connection, an injection molded plastic connection, soldered connection and/or welded connection.

Regarding claim 14, Roberts et al. disclose the component as claimed in claim 1, in which the plastic structure (24) is designed as a stiffening structure and/or a guide structure.

Regarding claim 15, Roberts et al. disclose the component as claimed in claim 1, in which the plastic structure (24) is of unipartite or multipartite design.

Regarding claims 18 and 27, Roberts et al. disclose the component as claimed in claim 1, in which the metal base body (22) is embodied as a hollow profile (Fig. 3), in particular as an open hollow profile (Fig. 3), with an edge (44) running along the longitudinal axis of the hollow profile on one or both sides, for example as a hat profile.

Regarding claim 19, Roberts et al. disclose the component as claimed in claim 1, as a dashboard carrier in a vehicle having a duct (14), in particular an air guide duct and/or a cable duct.

Regarding claim 20, Roberts et al. disclose the component as claimed in claim 1, as a crossrail (14) in a vehicle, in particular as a crossrail between the A-pillars of a vehicle or as a front end component.

Regarding claim 26, Roberts et al. disclose the component as claimed in claim 22, in which the metal base body (22) is provided with an edge (44) forming the fixing element (44), and is used as a prefabricated module.

21. Claims 16 and 21 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roberts et al.

Regarding claim 16, Roberts et al. disclose the component as claimed in claim 1, in which the plastic structure (24) is formed from a thermoplastic (column 2, line 39). It is unclear if the limitation that the thermoplastic is a fiber-reinforced and/or filled plastic is part of the claim. Roberts et al. does not disclose a fiber-reinforced plastic. Roberts et al. does disclose a plastic composite. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a fiber-reinforced plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. See also Ballas Liquidating Co. v. Allied industries of Kansas, Inc. (DC Kans) 205 USPQ 331.

Regarding claim 21, Roberts et al. disclose the component as claimed in claim 1 as a carrier element (14) in a vehicle, in particular as an A-, B-, C-, D-pillar carrier element, as chassis rail, as vehicle door sill or as roof post. It is unclear what the metes and bounds of this claim are. Roberts et al. disclose a cross rail that can be used as a carrier between the A-pillars. However, it is well known in the vehicle art to use the rail structure as taught by Roberts in other environments of the vehicle such as the chassis rail, door sill or roof post. Therefore it would have been obvious to one of ordinary skill in the art to use the rail of Roberts et al. in the known environments.

*Claim Rejections - 35 USC § 103*

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

24. Claims 3-5 and 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al.

Regarding claim 3-5 and 8, Roberts et al. disclose the component as claimed in claim 1. Roberts et al. does not disclose that the integrally formed fixing means is in a comb structure shape or a latching shape. It would have been an obvious matter of design choice to make the integrally formed fixing means of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. In re Dailey et al., 149 USPQ 47.

Regarding claim 17, Roberts et al. disclose the component as claimed in claim 1, in which the metal base body (22) is formed from a light metal, in particular aluminum (column 2, line 36), magnesium or titanium, or from fine steel. Roberts et al. do not disclose the wall thickness. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a wall thickness of 0.4 mm to 1.5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

25. Claims 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. in view of Wagenblast et al. (US Patent No. 6,503,585).

Regarding claim 13, Roberts et al. disclose the component of claim 1. Roberts et al. do not disclose a separate connecting element. Wagenblast et al. teach attaching separate elements (1,4) with separate connecting elements (5). It would have been obvious to one of ordinary skill in the art to include separate connecting elements as taught by Wagenblast et al. The motivation

would have been to provide a more secure connection between the metal base body and the plastic structure.

***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICIA L. ENGLE whose telephone number is (571) 272-6660. The examiner can normally be reached on Monday - Friday from 7:30am- 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia L Engle/

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Primary Examiner, Art Unit 3612